TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

No. 159

HORACE CLARK, JOSIAH G. GRAHAM AND JOHN B. WHITE, PLAINTIFFS,

vs.

JOHN G. BOUSFIELD AND JOHN POOLE.

ERROR TO THE SUPREME COURT OF THE DISTRICT OF COLUMBIA.

SUPREME COURT OF THE UNITED STATES.

No. 370.

DIODATE CLARK, JOSIAH G. GRAHAM AND JOHN B. WHITE, PLAINTIFFS,

vs.

JOHN G. BOUSFIELD AND JOHN POOLE.

CERTIFICATE OF DIVISION IN OPINION BETWEEN THE JUDGES OF THE CIRCUIT COURT OF THE UNITED STATES FOR THE NORTHERN DISTRICT OF OHIO.

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1 UNITED STATES OF AMERICA,
Northern District of Ohio:

At a stated term of the Circuit Court of the United States for the northern district of Ohio, begun and held at the city of Cleveland, in said district, on the first Tuesday of September, being the first day of said month, in the year of our Lord one thousand eight hundred and sixty-eight, and of the independence of the United States of America the ninety-third.

Present, the Honorable Noah H. Swayne, associate justice of the Supreme Court of the United States for the sixth judicial circuit, and the Honorable Charles T. Sherman, district judge.

Among the proceedings then and there had were the following, to wit:

Trespass on the case.

DIODATE CLARK, JOSIAH G. GRAHAM, JOHN B. White, *vs.* JOHN BOUSFIELD, JOHN POOLE. } No. 1635.

This is an action of trespass on the case, on letters patent granted by the United States to J. R. and A. J. Cross, dated Decem-
2 ber 27th, 1864, and assigned to the plaintiffs. The defendants, amongst other pleas, plead the general issue, with notice.

This cause coming on for trial at this term of the court, these two questions occurred:

First. Whether the second claim in said letters patent was for anything patentable other than under section 11 of the act of March 2nd, 1861, entitled "An act in addition to an act to promote the progress of the useful arts," and if not, whether the patent was not void.

Second. Whether said letters patent were not void for ambiguity in the specification.

On which questions the opinions of the judges were apposed. Whereupon, on motion and request of the defendants, by their counsel, the foregoing points of disagreement and said letters patent are now stated and ordered to be certified, under the seal of said court, to the Supreme Court of the United States, at their next session, to be decided by said Supreme Court, the said letters patent being as follows:

The United States of America to all to whom these presents shall come:

Whereas J. R. Cross and A. J. Cross, of Chicago, Illinois, have alleged that they have invented a new and useful apparatus for graining pails, which they state has not been known or used before their application, have made oath that they are citizens of the United States; that they do verily believe that they are the original and first inventors or discoverers of the said invention, and that

3 the same ha not, to the best of their knowledge and belief, been previously known or used; have paid into the treasury of the United States the sum of thirty-five dollars, and presented a petition to the Commissioner of Patents, signifying a desire of obtaining an exclusive property in the said invention, and praying that a patent may be granted for that purpose.

These are therefore to grant, according to law, to the said J. R. and A. J. Cross, their heirs, administrators or assigns, for the term of seventeen years from the twenty-seventh day of December, one thousand eight hundred and sixty-four, the full and exclusive right and liberty of making, constructing, using and vending to others to be used, the said invention, a description whereof is given in the words of the said J. R. and A. J. Cross, in the schedule hereunto annexed, and is made part of these presents.

In testimony whereof I have caused these letters to be made patent and the seal of the Patent Office has been hereunto affixed. Given under my hand at the city of Washington, this twenty-seventh day of December, in the year of our Lord one thousand eight hundred and sixty-four, and of the independence of the United States of America the eighty-ninth.

J. P. USHER,
Secretary of the Interior.

Countersigned and sealed with the seal of the Patent Office.
[SEAL.] D. P. HOLLOWAY,
Commissioner of Patents.

The schedule referred to in these letters patent and making part of the same:

4 To all whom it may concern:

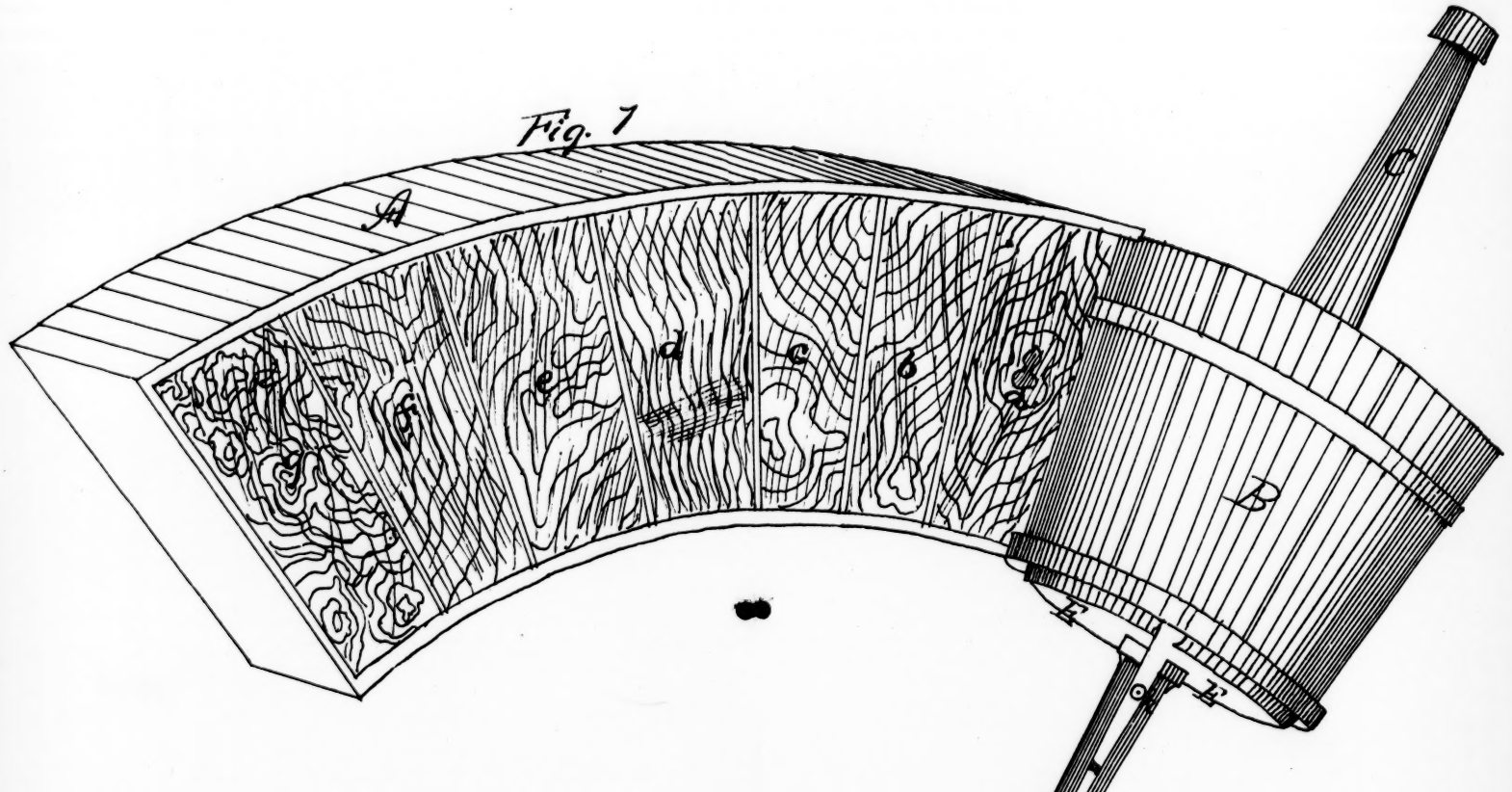
Be it known that we, J. R. Cross and A. J. Cross, of Chicago, in the county of Cook and State of Illinois, have invented a new and useful improvement in machines for graining pails and other analagous uses, and we do hereby declare that the following is a full, clear and exact description thereof, reference being had to the accompanying drawings, and the letters and figures marked thereon, forming part of this specification. In the said drawings, which are hereunto attached, figure 1 represents a perspective view of our invention; and figure 2 is a central sectional view of the pail or other vessel to be grained with the devices thereunto attached. The nature of our invention consists in constructing the elastic bed containing the impression or impressions of the device to be grained upon the pail in separate panels, each panel to be of different designs, so that, by moving the pail over the same, the various designs will be stamped upon the pail, thus producing a pail whose staves are painted in imitation of different kinds of woods. To enable those skilled in the art fully to understand how to construct and use our invention, we will proceed to describe the same with particularity, reference being made to the aforesaid drawings. A represents the

box or bed into which the elastic material, impressed with the required designs to be grained upon the pails is placed or framed, and may be constructed of wood or iron or any other material suitable for the purpose. The elastic bed upon which the desired impression is made presents a plane surface, whose area is included between the arcs of two concentric circles described upon radii whose difference in length is equal to the height of the pail or other vessel to be grained, the length of the exterior arc being equal to the circumference of the top or larger end of the pail, and the length of the interior arc being equal to the circumference of the bottom or smaller end thereof, and the corresponding ends of the said two arcs being joined by two straight lines. The curvatures of said arcs must be adapted to the different sizes of pails to be grained, and also to the different inclinations of their sides from the vertical, so that when the pail is adjusted properly upon said bed and rolled upon and over it, the upper or larger end shall follow the outer curve and the lower or smaller end shall follow the interior or smaller curve, with exactness and precision. The elastic bed may present one continuous or uniform design if desired; or it may be arranged in blocks or staves, each of different designs, as shown in figure 1, by the letters *a*, *b*, *c*, *d*, *e*, *f*, *g*, so that the pail or vessel grained thereon or thereby shall present the appearance of being constructed of different kinds or species of woods, as rosewood, oak, walnut and others. The elastic bed may be constructed of any suitable impressible material, as rubber or leather, but I consider the best material for the purpose to be a compound of glue and molasses, which is used for printer's rollers. The bed may also be constructed of separate pieces or blocks, as shown; or the material may be a single united mass, impressed by different designs, arranged in staves, so as to produce the same effect as when constructed in separate blocks. The same material may also be employed to imitate marbles and other ornamental stones. It may also be used for graining other wares, as for japanning and other similar purposes, and also for graining broom handles. It may be observed, however, that where the articles to be grained have upright or parallel sides the bed may be of rectangular form instead of the form shown. C, D, E and F represent the handles and other devices for affixing or attaching said handles C and F to the pails, to facilitate the operation of graining. D D are two circular plates fitting closely into the pail, as shown, which are rigidly attached to the handle C, and when introduced as shown into the pail, hold the same firmly. E E represent a circular plate divided in two parts, to each of which is rigidly attached the handles F F, as shown. The said handles F F are connected by a hinge at *h*, and between them is arranged a spring *s*, to throw said handles apart when not confined by the ring *r* upon the ends of the same. Having described the construction and nature of our invention, we will now describe the mode of operation and application of the same. The ring *r* being removed from the end of the handle F F, the opposite ends thereof approach each other, being forced together by the operation of the spring *s* and hinge *h*; and thus the two parts of the

J. R & A. J. Cross. Machine for Graining Pails.

Patented Dec. 27. 1864. No 45590.

Fig. 1



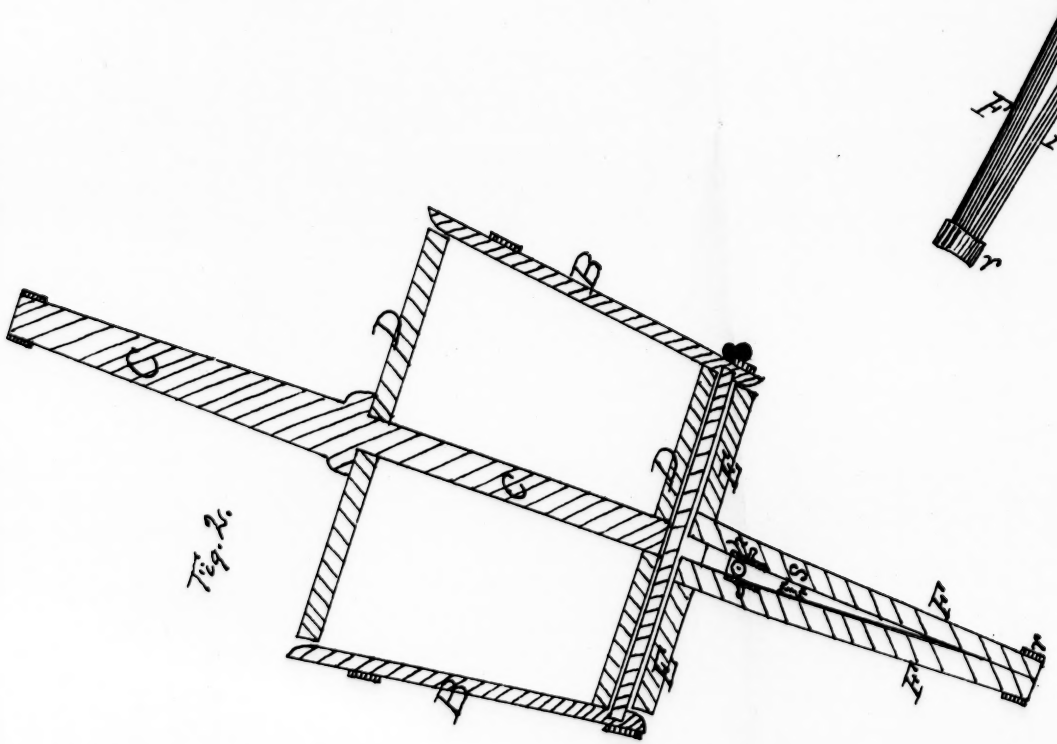

F
F
r
D
D
B
B
E
E
E

plate E E are drawn together, diminishing its size, so that it can readily introduced within the chime of the bottom of the pail, when, by pressing the ends of F F together and replacing the ring *r*, the plate E E is expanded and adjusted within said chime so as
7 firmly to fasten the handle F to the pail. The handle C is then readily inserted and adjusted within the pail, when the operator grasps the handles C F, and adjusts the pail upon the elastic bed, as shown: the paint or coloring matter having been previously applied thereto by means of a roller, or in any other suitable and convenient manner. The pail is then readily rolled across the bed, and is by this simple operation grained in the most beautiful manner, in staves in imitation of various woods or marbles, as before described, when the handles are detached and applied to another pail and the operation repeated. Instead of rolling the pail over said bed, the pail may be suspended upon the handles or their removable equivalents, and the elastic bed itself moved beneath the pail in a suitably arranged groove or track, producing the same result; or the application may be made in any other convenient and practical manner. Having described the nature, construction and operations of our machine for graining pails and other analagous uses, we will now specify what we claim as new therein and desire to secure by letters patent: First. We claim constructing the bed of elastic material used in graining machines, in the form herein shown, substantially as and for the purposes specified. Second. We claim arranging the elastic material aforesaid, whether curved or rectangular in form, in a series of distinct staves or designs, substantially as and for the purposes herein shown and set forth. Third. We claim the arrangement of the expansible plate E E and the
8 handles F F, provided with the hinge *h* and spring *s*, as and for the purposes described. Fourth. In combination with the last foregoing we claim the employment of the handle C and plates D D, as and for the purposes shown and described.

J. R. CROSS.
A. J. CROSS.

Witnesses—
L. S. COBURN.
W. E. MARRS.

[Here follows map marked page 8.]

UNITED STATES OF AMERICA, *Northern District of Ohio:*

I, Earl Bill, clerk of the Circuit Court of the United States for the northern district of Ohio, do hereby certify the foregoing to be a copy from the minutes.

Given under my hand and seal of office, at Cleveland, Ohio, on the ninth day of December, in the year of our Lord one thousand eight hundred and sixty-eight.

[SEAL.] EARL BILL, *Clerk.*

Endorsed: No. 1635. U. S. Circuit Court, northern district of Ohio. Diodate Clark et al. vs. John Bousfield et al. Certificate of opposition.

Supreme Court of the United States.

DIODATE CLARK, et al.,

Plaintiffs.

vs.

JOHN BOUSFIELD, et al.,

Defendants.

Certificate of Division of Opinion between Judges of Circuit Court of the United States for the Northern District of Ohio.

BRIEF FOR THE DEFENDANTS

BY

WILLEY & CARY and H. S. SHERMAN,

Of Cleveland, Ohio.

G. S. NEWCOMB & CO., BLANK BOOK MANUFACTURERS AND PRINTERS, CLEVELAND, O.

Supreme Court of the United States.

DIODATE CLARK, et al.,

vs.

JOHN H. BOUSFIELD, et al.

BRIEF FOR DEFENDANTS.

This case comes up on a certificate of division of opinion between the Judges of the Circuit Court of the United States for the Northern District of Ohio, upon two questions relating to Letters Patent granted to J. R. & A. J. Cross, December 27, 1864. For convenience of reference we append hereto the record of the case as here presented, which also contains the Letters Patent with their specification and drawing.

The questions presented are:

I

Whether the second claim in said Letters Patent was for any thing patentable, other than under section 11 of the act of March 2d, 1861, entitled "An Act in addition to an Act to promote the progress of the useful arts," and if not, whether the patent was not void.

Under this question we respectfully submit:

1st. That the second claim, if not void for ambiguity, is a claim for a design merely, and only patentable as such under section 11 of the act referred to in the question.

On referring to the statement of the nature of the invention, it is found to consist in constructing the elastic bed containing the impression or impressions of the device to be grained upon the pails in separate panels, each panel to be of different design, so that by

moving the pail over the same the various designs will be stamped upon the pail, thus producing a pail whose staves are painted in imitation of different kinds of woods.

This then being the declared object of the invention, to wit: the impressing of these particular designs, what is there in it beyond the mere matter of the design or printing surface—the design being shaped in such a way as to correspond with the surface to which the design is to be transferred—and does not the same necessity exist, in all cases, where designs are invented and sought to be applied?

Suppose that even the *first* claim, which presents the strongest suggestion of a machine or device, had been declaredly for a design, in what way would the statement of it necessarily vary from the terms there used? The declaration of invention would be for a new stave design, for ornamentation, to be imprinted on the pail, the design to conform to the surface of the object to be ornamented, to wit: the pail.

It is conceded in the specification that there is nothing new in the material of the bed or plate, and the printers' rollers, which are commonly known to be instruments for transferring coloring matter from one to another and to type, constructed of the materials to which preference is given in the specification, are known devices. Further, we call attention to the first claim itself as recognizing graining machines as already in use.

We have not in the record the benefit of the evidence as to various forms of plate of the same material used for graining and painting, but we suppose it to be matter of common knowledge, that such plates, besides printers' rollers, had been common to the arts almost from time immemorial, and as is apparently recognized by the language used in the first claim, which speaks of "constructing the bed of elastic material used in graining machines," and hence that this form of plate is simply the inevitable sequence or incident of the form of the design, so that the invention, if of any thing, is the invention of the design. Take any other case of design for painting or ornamenting

surfaces where the printing surface was to be applied to some object intended for it. The design *if new* could be patented as such, but could the form of the block on which the design was prepared, which is simply another term for the form of the design itself, be patented as a machine? If it can be in this case then it could be in all cases where the invention merely consisted in the discovery of a new design, and not in the shape of the printing block on which the design is impressed, which is a mere obvious and necessary incident to the design itself. This first claim declares that the form of the plate is "for the purposes specified." The purposes specified are the production of a pail ornamented by a design in staves, or representing staves. The matter of the *design* is the nature and object of the invention, and the terms "constructing the bed of elastic material used in graining machines in the form herein shown" are but another mode of describing the design to be impressed, to wit: that the outlines of the design shall correspond to the form of the pail.

We submit then that this first claim, even, when reduced to what it substantially means, in the light of other parts of the specification, and especially those parts which throw light on the state of the art, dercribes, if any thing, a new design, and only patentable as such if patentable at all.

U. S. Statutes, act of March 2, 1861, Ch. 88 § 11.

Wooster vs. Crane. M S. Benedict, J. (N. Y.) 1866, referred to in Law's patent and copyright laws, p. 204.

2d. But assuming that the first claim may possibly be construed to be for a machine or device, then we return to our immediate proposition that this second claim is clearly for a design.

And in support of our proposition, while we ask the Court to refer to the above suggestions concerning the first claim, and which are still more closely applicable to the second claim, we would add:

(*a*) That if the first claim is good as a claim for a device of a given form there was no necessity for the second claim, unless it was intended to cover the stave design as such, for the first claim covered

the construction of the bed as to form, and whether constructed of separate blocks or in one entire block.

(*b*) It cannot be presumed that the second claim was intended to again cover the use of distinct blocks; for the sub-dividing of a mass or plate into parts which were still to be used together as a mass or as one plate, would be obviously void for want of invention.

(*c*) The terms "in a series of distinct staves or designs" are evidently used synonymously or as convertible terms in this relation. If so they mean stave shaped designs, or designs as "set forth." If not, then the claim would be void for ambiguity, or for combining two classes of subjects in one claim, but in either case it embraces a claim for a design, which destroys the patent for incongruity, or rather by destroying its unity.

Curtis on Patents, §§ 107-110.

1. Mason, 475.

The nature and object of the invention, as stated in the specification, contemplated a design and the construction of a bed corresponding with the shape of the design, but as an obvious sequence or incident of the design. Nothing is claimed on the material or box or bed or its material, nor as to form could any thing be claimed in the way of invention, inasmuch as it involves the mere measurement of surface, the simplest of mechanical operations. Then it says, "the elastic bed may present one continuous or uniform design if desired, or it may be arranged in blocks or staves, each of different designs," meaning block or stave designs. Again it speaks of "different designs arranged in staves," which is but another form of representing stave designs. Again it speaks of the "pail being rolled across the bed and grained in staves in imitation of various woods or marbles."

The specification does not say, series of separate pieces or blocks, but a "series of distinct staves or designs," and the specification speaks of "different designs arranged in staves, impressed upon a single united mass, so as to produce the same effect as when con-

structed in separate blocks," evidently treating staves and designs as synonymous or convertible, the word "staves" meaning stave designs, so that from all these considerations it is obvious that stave designs impressed on a bed, whether curved or rectangular, for the purpose of transferring said stave designs to a pail or "other analogous uses," or to rectangular objects, is the substantial object or meaning of this second claim.

And in this connection we cite from the charge to the jury of Mr. Justice Swayne—portions of which charge are hereto appended—in which the learned Justice says, as follows:

"Now it seems to be well worthy of consideration whether this second claim in the original patent is not for a design to be impressed upon the bed in the curved form or in the rectangular form, and whether that is not the whole substance of the second claim of the patent. Now if this be within that section of the act, then it seems to us the question arises—the very serious question—as to the effect of this second claim. A patent can be avoided if it claims two distinct and independent inventions, and a patent can be avoided which contains a valid claim for a machine or instrument and which contains also a claim for a design, such as that which is described in the act of 1861, because they are patentable for different periods of time, and this patent is for a period of seventeeen years."

II.

The second question presented is "whether said Letters Patent were not void for ambiguity in the specification."

1st. That the first claim, taken in connection with the description, is uncertain as to whether the curved or rectangular form is intended, or *both*. Both forms are spoken of in the specification and both, and perhaps other forms, required by the subjects enumerated to be grained.

2d. As to what is to be embraced in the term "for the purposes specified," whether simply the graining of pails requiring a curved form of bed, or other subjects requiring or admitting a rectangular bed.

3d. Ambiguity in the second claim, as to whether the term "a series of distinct staves or designs" refers to the blocks into which the bed may be sub-divided, *and* designs, or to staves as another term for designs. If the former, then the claim is void as being for a design as well as for the plates or blocks, and if the latter, as being wholly for a design, belonging to another class of patentable subjects. Both claims are obnoxious to the further objection that it is uncertain whether "the purposes specified" are to grain a pail so that it shall have the appearance of having staves of different kinds of wood or of the same kind.

4th. Ambiguity in not distinguishing, by definite terms of description and exclusion, the extent of ground covered by the patent, in order that the public may know just what is claimed and what is not claimed.

III.

Finally we submit that this patent should be held void under both of the questions submitted for the determination of the Court. And it would seem to be apparent from the specification of the patent, showing as it does, that there is nothing new in graining plates or machines, or in the material proposed, that nothing can be claimed to have been done by the patentee except to measure the surface of a pail and construct a stave-designed plate to fit that measurement, (obviously involving no invention but merely an adaptation by measurement of one surface to another) so that there can be nothing in this patent as an invention, which would incline a Court, for the purpose of upholding it, to solve its ambiguities or endeavor to harmonize its incongruous claims.

Respectfully submitted,

GEORGE WILLEY,
JOHN E. CARY AND
H. S. SHERMAN,
For Defendants.

Extracts from the Charge to the Jury of

MR. JUSTICE SWAYNE.

"Now it seems to us to be equally clear that this second claim—that which is equally prominent and made equally emphatic—is for distinct staves or designs impressed on a bed in that form which lies before you, or a rectangular form, for the purpose of being transferred upon wares, that may be brought in contact with it. This we think is what in this claim, taken in connection with the residue of the specification, the patent was designed to secure to the inventor, and, if valid, it goes to this extent and goes no further."

[Here follow remarks of the learned Judge in relation to a re-issue of this patent, which we omit as the re-issued patent is not here of record.]

The charge then proceeds:

"Now I wish to remark in this connection that there is a difficulty in the case, to which I adverted this morning with a view of drawing forth some light on the subject, and it has not as yet perhaps been considered and discussed quite as fully as the difficulty and importance of the subject demand. The act of 1861 provides, among other things, that inventors of any new and original design or impression or ornament to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern or print or picture to be worked into or worked on, or printed or painted or cast or otherwise fixed on any article of manufacture, or any new and original shape, or configuration of any article or manufacture not known or used by others before, may obtain Letters Patent therefor, for three and a half, seven or fourteen years, as he may elect in his application, and the amount of fee to be charged to be according to the term he desires.

"*Now it seems to be well worthy of consideration whether this second claim in the original patent is not for a design and nothing but a design, to be impressed on the bed in the curved form or in the rectangular form, and whether that is not the whole substance of the second claim of the patent. Now if this be within that section of the act, then it seems to us the question arises, the very serious question, as to the effect of this second claim. A patent can be avoided if it claims two distinct and independent inventions, and a*

patent can be avoided which contains a valid claim for a machine or instrument and which contains also a claim for a design, such as that which is described in the act of 1861, *because they are patentable for different periods of time, and this patent is for a period of seventeen years.* That, however, is a subject on which my learned brother and myself have deemed it proper to divide in opinion."

[And in order to show the state of the art, as an aid perhaps to the construction of the patent, and as bearing upon the question of invention or value of this patent in any view of it, we cite further from the charge as follows:]

"Then a material question arises in this connection to which I will call the attention of the Jury for a moment, and that is in regard to the state of the art, as it is called, when this patent was taken out by these patentees. In the first place the Jury will remember that the patent of Boynton of 1832 describes a process of impressing ornamental designs, and transferring them from an elastic substance upon which they are placed upon the object to which they are to be transferred. Now I suppose it is proper to remark, right here, that an enlargement to any extent of that instrument described in Boynton's patent would not involve anything of invention. It may be much larger or smaller, and it would not effect the result whether there were one ornament or many placed upon the substance to be used for making the transfer. Nor would it involve any invention if instead of applying that instrument laterally, the object to receive the design be laid down and the instrument laid upon it, or it laid down upon the object to which the transfer is to be made All that would involve no invention. This was the state of the art in 1831 as regards the patent, but I understand from the testimony of Mr. Adams that at a very early period, much earlier than the date of the Adams patent which was in 1861, the use of such machines for the purpose of graining and various other kindred purposes was well known in the arts, and I suppose, as I have already remarked in connection with the Boynton patent, whether there was a lateral presure or whether the subject was laid down and the object laid on it, or whether it were one shape or another, whether it should have one size or another, would be quite immaterial as regards any patentable principle, because there would be involved no invention in it.

"Now in 1861 a patent was issued to Adams which has been adverted to and considerably discussed by the learned counsel for the defendants. He says in that patent; 'The nature of my invention consists in producing a piece of leather of the required size and carving or pressing one side of it so as to imitate the lines of the wood or marble I wish to grain,' and then he goes on and describes

how that is attached to a block of wood, and covers it with cloth, by means of which it is made to operate. He then says: 'To enable others skilled in the art to use my invention I will succinctly describe my manner of using it: "A" represents upon the drawing the crescent shaped board, "C" represents the leather, gutta-percha or metal face upon which is cut or carved the style or figure to be transferred,' and then 'I usually tack or fasten a piece of thick cloth or other similar material on the table or board larger somewhat than the face of the machine. I then spread my stain or graining color on the cloth to saturation. I then properly prepare the substance to be grained in the usual way, and when ready to receive the graining application, I press the curved face of my machine on the cloth aforesaid saturated with stain of the graining color till the carved lines and figures are wet and apply it to the substance prepared to be grained as aforesaid, gently pressing the machine from one end to the other, when it will be found the lines and figures as carved on the face of said machine will be transferred in color to the ground of the substance prepared as aforesaid, producing, if properly done, all the shades, lines, figures, etc., peculiar to the wood or marble it is desired to imitate, then blend and glaze properly and the work is done' He then says: 'For the face of my machine I have used gutta-percha, india rubber and other similar materials capable of being carved or stamped with lines and figures as well as metals moulded in proper shape. But I find no material so well adapted to the purposes desired as leather as aforesaid.' Again: 'The machine may be made of any required size so as to grain any size panel or surface at one impression and the lines may be cut so as to fully represent any texture and feature of the wood to be imitated, for instance, a set of machines may be required of different sizes and finish on the face so that graining a door of several panels in imitation of oak, all the various growths of the wood may be faithfully represented.,

"Now conceding that patent to be valid, and for the purpose of this case it is immaterial whether it is so or not, I shall hold that if he was the author of the processes or art of graining otherwise than by hand, if nothing of the kind had been done before, his invention covered the entire ground, and then I should have no difficulty in holding and instructing you to make that flat, make it of any size, and carve upon it any variety of figures representing a separate panel or any number of separate panels that may be required upon a plain surface, yet this one would be substantially the same as his invention—would be a violation of his patent—would be of the precise nature as that implement—make it flat and put these different panels upon it, these

different designs, the different ornamentation to be transferred, and if that patent were valid I should deem it my duty to instruct you as a matter of law, though undoubtedly it would also involve a question of fact, but I should instruct you to consider very seriously whether there was any invention in that bed before you or only mere mechanical skill, whether there was anything of this element of invention involved in those alterations of it, in its construction, in its different dimensions and shape for the purpose of applying it in the new manner by laying it down and impressing upon it the surface to be grained, conceding the novelty of the invention. Of this patent I should instruct you to inquire whether there was anything new in substance different from the original patent, and if not that there could not be any ground upon which the parties making use of the work, the parties using this means to do such work, notwithstanding these changes in form, could be considered other than as infringers under that patent.

"Now we come down in the light of this state of the art, to the invention described in this patent and which is the ground of the controversy in this case, that portion of it to which this controversy relates.

"Now carved surfaces to represent grained wood were known long before the invention of these patentees. There was nothing new in that; there is nothing new, as you will have perceived from the language of the patent which I last read to you, in the Adams patent; there is nothing new in transferring the appearance of the different kinds of wood; there is nothing new in having panels, and panels of different sizes; there is nothing new in all that. Now then what is there new, if anything, in that patent? Well, it is claimed and proved that this carved form of bed is new, and it is proved that the design of staves or panels converging to a common center is new, and especially and emphatically is it claimed that the application of these instrumentalities or means to the graining of pails is entirely new—were unknown in the arts until the invention described in the patent and intended to be secured by it was made by these patentees, one or both of them as the case may be. That is a different point of enquiry to which I will call your attention in another connection. Now, throwing out of view as a matter with which we do not propose to encumber this case, as to the validity of this patent by reason of its containing a claim for a design as well as a machine, throwing that out of view, then two questions arise for your consideration, which are substantially but one question—two in form rather than in fact. Is there any inventive discovery or thought in these two things?

Now that may be tested in this way: If a change that is made from what is old or what is patented is such as any man of good sense would be able to make, if it be such as any mechanic skilled in kindred business, a man of good sense, fair average ability, would have devised if applied to, to get up something for that purpose; and then other matters to which I have adverted as covered by those and other patents are not covered by them; if by these lights a skilled and sensible mechanic would have so changed what was known antecedently to what is claimed in this patent, if in other words it is a mere mechanical result requiring only mechanical skill and ability, then there is not that invention in the case which is necessary to sustain the patent."

RECORD.

CLARK, et al, vs. BOUSFIELD, et al.

UNITED STATES OF AMERICA,

Northern District of Ohio:

At a stated term of the Circuit Court of the United States for the Northern District of Ohio, begun and held at the city of Cleveland, in said district, on the first Tuesday of September, being the first day of said month, in the year of our Lord one thousand eight hundred and sixty eight, and of the independence of the United States of America the ninety-third.

Present, the Honorable Noah H. Swayne, associate justice of the Supreme Court of the United States for the sixth judicial circuit. and the Honorable Charles T. Sherman, district Judge.

Among the proceedings then and there had were the following, to wit:

Trespass on the case.

DIODATE CLARK, JOSIAH G. GRAHAM, JOHN B. WHITE, *vs.* JOHN BOUSFIELD, JOHN POOLE.	No. 1635.

This is an action of trespass on the case on Letters Patent granted by the United States to J. R. and A. J. Cross, dated December 27th, 1864, and assigned to the plaintiffs. The defendants, amongst other pleas, plead the general issue, with notice.

This cause coming on for trial at this term of the court, these two questions occurred:

First. Whether the second claim in said Letters Patent was for anything patentable other than under section 11 of the act of March 2nd, 1861, entitled "An act in addition to an act to promote the progress of the useful arts," and if not, whether the patent was not void.

Second. Whether said Letters patent were not void for ambiguity in the specification.

On which questions the opinions of the Judges were opposed. Whereupon, on motion and request of the defendants, by their counsel, the foregoing points of disagreement and said Letters Patent are now stated and ordered to be certified, under the seal of said court, to the Supreme Court of the United States, at their next session, to be decided by said Supreme Court, the said Letters Patent being as follows:

The United States of America to all to whom these presents shall come:

Whereas J. R. Cross and A. J. Cross, of Chicago, Illinois, have alleged that they have invented a new and useful apparatus for graining pails, which they state has not been known or used before their application, have made oath that they are citizens of the United States; that they do verily believe that they are the original and first inventors or discoverers of said invention, and that the same has not, to the best of their knowledge and belief, been previously known or used; have paid into the treasury of the United States the sum of thirty-five dollars, and presented a petition to the Commissioner of Patents, signifying a desire of obtaining an exclusive property in the said invention, and praying that a patent may be granted for that purpose.

These are therefore to grant, according to law, to the said J. R. and A. J. Cross, their heirs, administrators or assigns, for the term of seventeen years, from the twenty-seventh day of December, one thousand eight hundred and sixty-four, the full and exclusive right and liberty of making, constructing, using and vending to others to be used, the said invention, a description whereof is given in the words of the said J. R. and A. J. Cross, in the schedule hereunto annexed, and is made part of these presents.

In testimony whereof I have caused these letters to be made patent and the seal of the Patent Office has been hereunto affixed. Given under my hand at the city of Washington, this twenty-seventh day of December, in the year of our Lord one thousand eight hundred and sixty-four, and in the independence of the United States of America the eighty-ninth.

J. P. USHER,
Secretary of the Interior.

Countersigned and sealed with the seal of the Patent Office.

[SEAL.]

D. P. HOLLOWAY,
Commissioner of Patents.

The schedule referred to in these Letters Patent and making part of the same:

To all whom it may concern:

Be it known that we, J. R. Cross and A. J. Cross of Chicago, in the county of Cook and State of Illinois, have invented a new and useful improvement in machines for graining pails and other analogous uses, and we do hereby declare that the following is a full, clear and exact description thereof, reference being had to the accompanying drawings, and the letters and figures marked thereon, forming part of this specification. In the said drawings, which are hereunto attached, figure 1 represents a perspective view of our invention, and figure 2 is a central sectional view of the pail or other vessel to be grained with the devices thereunto attached. The nature of our invention consists in constructing the elastic bed containing the impression or impressions of the device to be grained upon the pail in separate panels, each panel to be of different designs, so that, by moving the pail over the same, the various designs will be stamped upon the pail, thus producing a pail whose staves are painted in imitation of different kinds of woods. To enable those skilled in the art fully to understand how to construct and use our invention, we will proceed to describe the same with particularity, reference being made to the aforesaid drawings: A represents the box or bed into which the elastic material, impressed with the required designs to be grained upon the pails is placed or framed, and may be constructed of wood or iron or any other material suitable for the purpose. The elastic bed upon which the desired impression is made presents a plane surface, whose area is included between the arcs of two concentric circles described upon radii whose difference in length is equal to the height of the pail or other vessel to be grained, the length of the exterior arc being equal to the circumference of the top or larger end of the pail, and the length of the interior arc being equal to the circumference of the bottom or smaller end thereof, and the corresponding ends of the said two arcs being joined by two straight lines. The curvatures of said arcs must be adapted to the different sizes of pails to be grained, and also to the different inclinations of their sides from the vertical, so that when the pail is adjusted properly upon said bed and rolled upon and over it, the upper or larger end shall follow the outer curve and the lower or smaller end shall follow the interior or smaller curve, with exactness and precision. The elastic bed may present one continuous or uniform design if desired; or it may be arranged in blocks or staves, each of different designs, as shown in figure 1, by the letters *a*, *b*, *c*, *d*,

e, *f*, *g*, so that the pail or vessel grained thereon or thereby shall present the appearance of being constructed of different kinds or species of woods, as rosewood, oak, walnut and others. The elastic bed may be constructed of any suitable impressible material, as rubber or leather, but I consider the best material for the purpose to be a compound of glue and molasses, which is used for printers' rollers. The bed may also be constructed of separate pieces or blocks, as shown; or the material may be a single united mass, impressed by different designs, arranged in staves, so as to produce the same effect as when constructed in separate blocks. The same material may also be employed to imitate marbles and other ornamental stones. It may also be used for graining other wares, as for japanning and other similar purposes, and also for graining broom handles. It may be observed, however, that where the articles to be grained have upright or parallel sides, the bed may be of rectangular form instead of the form shown. C, D, E and F represent the handles and other devices for affixing or attaching said handles C and F to the pails, to facilitate the operation of graining. D D are two circular plates fitting closely into the pail, as shown, which are rigidly attached to the handle C, and when introduced, as shown, into the pail, hold the same firmly. E E represent a circular plate divided in two parts, to each of which is rigidly attached the handles F F, as shown. The said handles F F are connected by a hinge at *h*, and between them is arranged a spring *s*, to throw said handles apart when not confined by the ring *r* upon the ends of the same. Having described the construction and nature of our invention, we will now describe the mode of operation and application of the same. The ring *r* being removed from the end of the handle F F, the opposite ends thereof approach each other, being forced together by the operation of the spring *s* and hinge *h*; and thus the two parts of the plate E E are drawn together, diminishing its size, so that it can be readily introduced within the chime of the bottom of the pail, when by pressing the ends of F F together and replacing the ring *r*, the plate E E is expanded and adjusted within said chime so as firmly to fasten the handle F to the pail. The handle C is then readily inserted and adjusted within the pail, when the operator grasps the handles C F, and adjusts the pail upon the elastic bed, as shown; the paint or coloring matter having been previously applied thereto by means of a roller, or in any other suitable and convenient manner. The pail is then readily rolled across the bed, and is by this simple operation grained in the most beautiful manner, in staves in imitation of various woods or marbles, as before described, when the handles are detached

and applied to another pail and the operation repeated. Instead of rolling the pail over said bed, the pail may be suspended upon the handles or their removable equivalents, and the elastic bed itself moved beneath the pail in a suitably arranged groove or track, producing the same result; or the application may be made in any other convenient and practical manner. Having described the nature, construction and operations of our machine for graining pails and other analogous uses, we will now specify what we claim as new therein and desire to secure by letters patent: First. We claim constructing the bed of elastic material used in graining machines, in the form herein shown, substantially as and for the purposes specified. Second. We claim arranging the elastic material aforesaid, whether curved or rectangular in form, in a series of distinct staves or designs, substantially as and for the purposes herein shown and set forth. Third. We claim the arrangement of the expansible plate E E and the handles F F, provided with the hinge *h* and spring *s*, as and for the purposes described. Fourth. In combination with the last foregoing we claim the employment of the handle C and plates D D, as and for the purposes shown and described.

J. R. CROSS.
A. J. CROSS.

Witnesses,
L. S. COBURN.
W. E. MARRS.

[Here follows map marked page 8.]

UNITED STATES OF AMERICA,
Northern District of Ohio:

I, Earl Bill, clerk of the Circuit Court of the United States for the Northern District of Ohio, do hereby certify the foregoing to be a copy from the minutes.

Given under my hand and seal of office, at Cleveland, Ohio, on the ninth day of December, in the year of our Lord one thousand eight hundred and sixty-eight.

[SEAL.] EARL BILL, *Clerk.*

Endorsed: No. 1635. U. S. Circuit Court, Northern District of Ohio. Diodate Clark et al. vs. John Bousfield et al. Certificate of opposition.

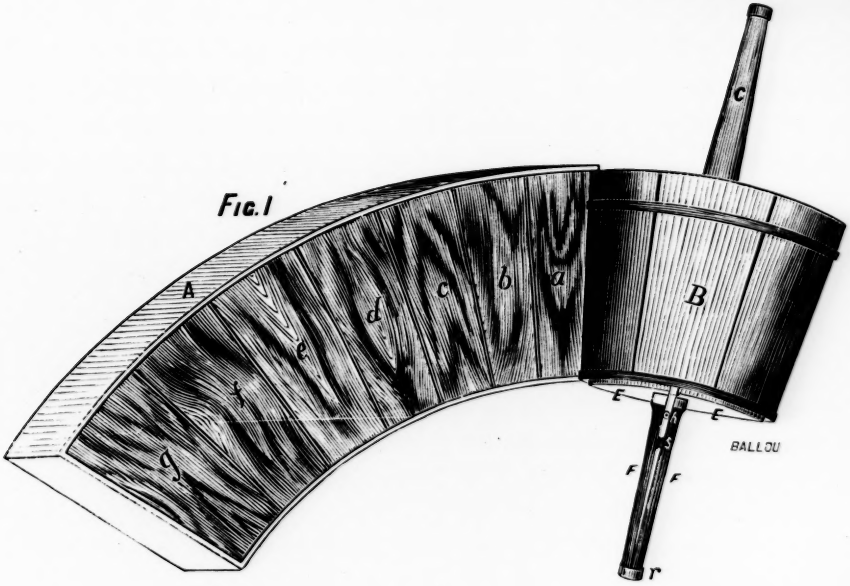


FIG. 1
A
a
b
c
d
e
B
c
E
E
F
F
r
BALLOU

Supreme Court of the United States.

DIODATE CLARK, JOSIAH G. GRAHAM AND JOHN B. WHITE,

vs.

JOHN G. BOUSFIELD AND JOHN POOLE.

Certified to the Supreme Court of the United States from the Circuit Court of the U. S. for the Northern District of Ohio, on the Opinions of the Circuit Judges being opposed.

ARGUMENT OF

JASON CANFIELD,

FOR PLAINTIFFS.

FAIRBANKS, BENEDICT & CO., PRINTERS, HERALD OFFICE, CLEVELAND, OHIO.

Supreme Court of the United States.

No. 370.

DIODATE CLARK, JOSIAH G. GRAHAM AND JOHN B. WHITE, PLAINTIFFS,

vs.

JOHN G. BOUSFIELD AND JOHN POOLE.

This case comes into this Court by reason of the opinions of the Judges of the Circuit Court, for the Northern District of Ohio, being opposed on the construction of the patent which is the subject of this suit, in the following particulars.

FIRST. Whether the second claim in said letters patent was for anything patentable, other than under section 11 of the act of March 2, 1861, entitled "An act in addition to an act to promote the progress of the useful arts," and if not, whether the patent was not void.

SECOND. Whether said letters patent were not void for ambiguity in the specification.

The above questions relate to, and arise out of the following language of the patent, viz:

"Be it known that we, J. R. Cross and A. J. Cross, of Chicago, in the county of Cook, and State of Illinois, have invented a new and useful improvement in machines, for graining pails, and other analagous uses; and we do hereby

declare, that the following is a full, clear and exact description thereof, reference being had to the accompanying drawings, and the letters and figures marked thereon, forming part of this specification. In the said drawings, which are hereunto attached, Figure 1 represents a perspective view of our invention, and Figure 2 is a central sectional view of the pail, or other vessel to be grained, with the devices thereunto attached.

"The nature of our invention consists in constructing the elastic bed, containing the impression or impressions of the device to be grained upon the pail, in separate panels, each panel to be of different designs, so that by moving the pail over the same, the various designs will be stamped upon the pail, thus producing a pail whose staves are painted in imitation of different kinds of wood.

"To enable those skilled in the art fully to understand how to construct and use our invention, we will proceed to describe the same with particularity, reference being made to the aforesaid drawings. A represents the box or bed into which the elastic material, impressed with the required designs to be grained upon the pails, is placed or framed, and may be constructed of wood or iron, or any other material suitable for the purpose.

"The elastic bed upon which the desired impression is made, presents a plain surface, whose area is included between the arcs of two concentric circles, described upon the radii, whose difference in length is equal to the height of the pail, or other vessel to be grained; the length of the exterior arc being equal to the circumference of the top or larger end of the pail, and the length of the interior arc being equal to the circumference of the bottom or smaller end thereof, and the corresponding ends of the said two arcs being joined by two straight lines.

"The curvatures of said arcs must be adapted to the different sizes of pails to be grained, and also to the different inclinations of their sides from the vertical, so that when the pail is adjusted properly upon said bed, and rolled upon and over it, the upper or larger end shall follow the outer curve, and the lower or smaller end shall follow the interior or smaller curve, with exactness and precision.

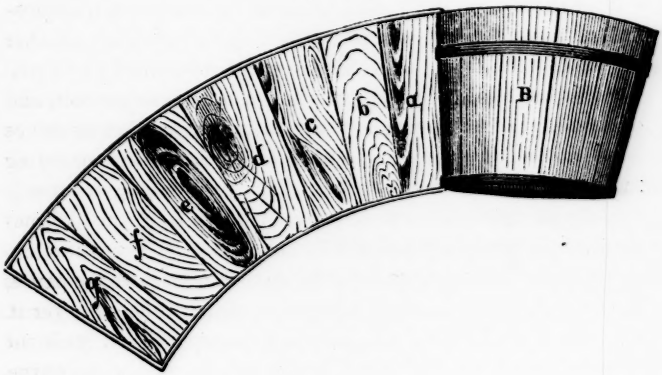
"The elastic bed may present one continuous or uniform design if desired, or it may be arranged in blocks, or staves, each of different designs, as shown in Figure one (1) by the letters *a*, *b*, *c*, *d*, *e*, *f*, *g*, so that the pail or vessel grained thereon, or thereby, shall present the appearance of being constructed of different kinds or species of woods, as rosewood, oak, walnut and others.

"The elastic bed may be constructed of any suitable impressible material, as rubber or leather, but I consider the best material for the purpose to be a compound of glue and molasses, which is used for printers' rollers.

"The bed may also be constructed of separate pieces or blocks, as shown; or the material may be a single united mass, impressed by different designs, arranged in staves so as to produce the same effect as when constructed in separate blocks. The same material may also be employed to imitate marbles, or other ornamental stones. It may also be used for graining other wares, as for japanning and other similar purposes, and also for graining broom handles.

"It may be observed, however, that where the articles to be grained have upright or parallel sides, the bed may be of rectangular form, instead of the form shown."

Figure 1 is here shown.



And the claims upon the part of the Patent above referred to, are as follows:

"FIRST. We claim constructing the bed of elastic material used in graining machines in the form herein shown, substantially as and for the purposes specified.

"SECOND. We claim arranging the elastic material aforesaid, whether curved or rectangular in form, in a series of distinct staves or designs, substantially as and for the purposes herein shown and set forth."

The first question which arises is this: Whether the 2d claim is, in substance, a claim for a design, instead of a claim for a principle in an apparatus for graining pails and other analagous uses.

If it is a design, it should have been patented under section 11 of an act of March 2, 1861, (Volume 12, Statutes at Large, 246,) entitled "An act in addition to an act to promote the progress of the useful arts."

If the 2d claim is for a principle in an apparatus for graining pails and other analagous uses, then it does not come under said section 11 of the act of 1861, but under the act of July 4, 1836, known as "An act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose," 5th Statutes at Large, page 117.

Judge Grier, in the case of Corning vs. Burden, 15th Howard, on page 268, has well and concisely defined the principle patentable as a machine, in the language following:

"It is for the discovery or invention of some practicable method or means of producing a beneficial result, or effect itself. It is when the term process is used to represent the means or method of producing a result, that it is patentable; and it will include all methods or means which are not effected by mechanism or mechanical combinations.

"But the term process is often used in a more vague sense, in which it cannot be the subject of a patent; thus, we say that a board is undergoing the process of being planed, grain of being ground, iron of being hammered or rolled. Here the term is used subjectively or passively, as applied to the material

operated on, and not to the method or mode of producing that operation, which is by mechanical means or the use of a machine, as distinguished from a process.

"In this use of the term it represents the function of a machine, or the effect produced by it on the material, subjected to the action of the machine. But it is well settled that a man cannot have a patent for the function or abstract effect of a machine, but only for the *machine* which produces it."

Now, in this case, our 2d claim in our patent is for the machine which produces the effect, and not for the effect itself; in other words, it is for a machine which grains a pail in staves, which staves represent different kinds of wood, and not for the impression put upon the pail, representing staves of different kinds of wood.

The means of producing this effect on the pail, is our machine, which comes under the act of 1836, the effect as propuced, is a design which comes under the 11th section of the act of 1861, and for which we claim nothing.

Judge Story, in 1st Gallison, Whitemore et al. vs. Cutler, on page 480, has defined the principle of a machine which applies to the act of 1836. (As the language of the act of February 21, 1793, which was repealed by the act of July 4, 1836, so far as it relates to the subject of patents, is the same.) See Statutes at Large, vol. 1, page 318, where he says: "By the principles of a machine (as these words are used in the statute) is not meant the original elementary principles of motion which philosophy and science have discovered, but the *modus operandi*, the peculiar device or manner of producing any given effect."

And the peculiar device of putting this grain upon pails, so as to represent staves of different kinds of wood, as shown in our patent, is what is embodied in our second claim.

Now, to test this farther, let us suppose a case of infringement of our second claim. (If our second claim is for a machine,) then the infringement will be in the use, sale, or manufacture of machines which substantially embody our mode of operation, and thereby obtain the same kind of result as was reached by the patentee's invention.

15th Howard, Winnans et al vs. Denmead, 344.

But if our second claim is for a design, then it is the use of a design which produces substantially the same appearance, which infringes our claim.

Root vs. Ball, 4th McLean, 177.

Now, a patent for a design is not for the mode of producing an effect or design, but is for the design itself, as produced.

What we ask protection for, in our second claim, is a machine for the graining of pails and similar bodies, (the inclination of the sides of which may vary from the vertical,) as shown in Figure 1 of the patent, the bed of which shall be constructed as set forth in said patent, and into which bed is impressed the elastic material, arranged in a series of distinct staves or designs, substantially as shown by *a*, *b*, *c*, *d*, *e*, *f*, *g*, in Figure 1.

We claim nothing on the staves or designs, so far as the particular figure, picture, or representation impressed on the staves, in and of itself, is concerned; but what we do claim is the principle of the machine, when so arranged as, by its use, to transfer the imitation of the staves to the pail, or to other conical surfaces, or to cylinder surfaces.

The making of these staves would be no infringement of our second claim; neither would the selling of the design which we put on our staves be an infringement; but to make or use a bed like ours, with the blocks of staves arranged as ours are, in graining pails and like surfaces, would be an infringement.

Again, if this second claim is for a design, what does it cover? The size of the staves are not uniform in the bed—some beds have them wider than others; and then, there is no uniformity of design upon the staves.

This machine is now universally used by the manufacturers of pails and wooden ware, and yet the particular design of each machine, so far as the grain on the staves is concerned, is different, so that each manufacturer is enabled to identify his own ware by the particular grain on the stave—by its own countenance, so to speak.

We are not limited to the imitation of any particular wood in the making of our machines, nor to any particular arrange-

ment of the imitations of different kinds of woods in our bed. If this be so, and if our second claim is for a design, then it must be for a variable one, for in the patent of a design we patent the appearance.

Under section 11 of the act of 1861, the property secured the patentee is in the design, the picture, in and of itself, without relation to the thing or principle which makes it.

Act of March 2, 1861.

"SEC. 11. *And be it further enacted,* That any citizen or citizens, or alien or aliens, having resided one year in the United States, and taken the oath of his or their intention to become a citizen or citizens, who, by his, her, or their own industry, genius, efforts and expense, may have invented or produced any new and original design, or a manufacture, whether of metal or other material or materials, and original, for a bust, statue, or bas-relief, or composition in alto or basso-relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked on or printed, or painted, or cast, or otherwise fixed on any article of manufacture, or any new and original shape or configuration of any article of manufacture, not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor, and who shall desire to obtain an exclusive property or right therein, to make, use, and sell and vend the same, or copies of the same, to others, by them to be made, used and sold, may make application in writing to the Commissioner of Patents, expressing such desire; and the Commissioner, on due proceedings had, may grant a patent therefor, as in the case now of application for a patent, for a term of three and one-half years, or for the term of seven years, or for the term of fourteen years, as the said applicant may elect in his application:

"*Provided,* That the fee to be paid in such application shall be, for the term of three years and six months, ten dollars, for

seven years, fifteen dollars, and for fourteen years, thirty dollars: *And provided*, that the patentees of designs under this act, shall be entitled to the extension of their respective patents for the term of seven years from the day on which said patents shall expire, upon the same terms and restrictions as are now provided for the extension of letters patent."

And this is further evident when we contrast the latter part of Section 11: "Who shall desire to obtain an exclusive property or right therein to make use, sell and vend the same, or copies of the same to others, &c.," with Section 6 of the act of July 4th, 1836.

Act of July 4th, 1836.

"SEC. 6. *And be it further enacted*, That any person, or persons, having discovered or invented any new and useful art, machine, manufactnre or composition, or any new and useful improvement on any art, machine, manufacture or composition of matter not known or used by others before his or their discovery or invention thereof, and not at the time of his application for a patent, in public use or on sale with his consent and allowance as the inventor or discoverer; and shall desire to obtain an exclusive property therein, may make application in writing to the Commissioner of Patents, expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor. But before any inventor shall receive a patent for any such new invention, or discovery, he shall deliver a written description of his invention, or discovery, and of the manner and process of making, constructing, using and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person, skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound and use the same. And in case of any machine, he shall fully explain the principle and the several modes in which he has contemtemplated the application of that principle, or character, by which it may be distinguished from other inventions; and shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention, or discov-

ery. He shall furthermore accompany the whole with a drawing, or drawings, and written references where the nature of the case admits of drawings, or with specimens of ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment where the invention or discovery is a composition of matter; which description and drawings, signed by the inventor and attested by two witnesses, shall be filed in the Patent Office. And he shall moreover furnish a model of his invention, in all cases which admit of representation by model, of a convenient size to exhibit advantageously its several parts. The applicant shall also make oath or affirmation that he does verily believe that he is the original and first inventor, or discoverer of the art, machine, composition or improvement for which he solicits a patent, and that he does not know or believe that the same was ever before known or used, and also of what country he is a citizen; which oath or affirmation may be made before any person authorized by law to administer oaths."

Now in case of a design it is not necessary to set out the "manner and process of making, constructing, using and compounding the same, in such full, clear and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or sicence to which it appertains, or with which it is most nearly connected, to make, construct, compound and use the same;" for the obvious reason that it is not the principle of the machine which makes the design that is patented, but the design itself; consequently the public have no right to know how it is made, as they neither purchase or obtain a right in the making of a design.

But under the act of July 4th, 1836, the manner of constructing, using, &c., "must be set forth in full, clear, and exact terms, so as to enable any one skilled in the art, &c.," to construct and use the same; and without such a description as this the patent is void.

Parker vs. Stiles, 5 McLean, 55.

Brooks vs. Bicknell, 3 McLean, 441.

And the English and American authorities concede the law to be as given by Judge Buller in the case of King vs. Arkwright. 3 E. C. L., p. 34. Note.

"A man to entitle himself to a patent must disclose his secret, and specify his invention in such a way that others of the same trade, who are artists, may be taught to do the thing for which the patent is granted, by following the directions of the specifications, without any new invention or addition of their own. *2d.* He must so describe it that the public may, after the expiration of the term, have the use of the invention in as cheap and as beneficial a way as the patentee himself uses it."

And this descriptive matter, which is vital to the validity of the patent, under the act of July 4th, 1836, is not referred to in the act of March 2d, 1861, and for the reason that the act of July 4th, 1836, patents the working principle of a machine when in use, and therefore the necessity of knowing how to put this principle at work; while the act of March 2d, 1861, patents the effect—the appearance only, without saying any thing about the means of producing it.

Now to bring our machine under the act of March 2d, 1861, all we could do with it, would be to sell it as a design, not to give the right to grain pails, &c., by rolling pails over it, for in so doing we assume to own the *principle* of the operation, and if we do own it, it is because we come under the act of July 4th, 1836, for it is the *cause* which produces the effect, which is patented under the act of July 4th, 1836, and the effect only which is patented under the act of March 2d, 1861.

Booth vs. Gurrelly, 1 Blatchford, 247.

Now what we claim by our patent is: "A new and useful improvement in machines for graining pails, and other analagous uses," substantially as set forth in the description and drawings of the patent.

That on the machine as set forth and described in the patent we make two claims:

FIRST. The *form* when constructed of the elastic material used in graining machines for the purpose of graining pails and other analagous uses.

SECOND. That so arranging the elastic material in the bed, for graining a section of a cone, like a pail, or a cylinder, in

a series of distinct staves, or designs, as shown by *a, b, c, d, e, f, g,* Figure 1.

As a farther test as to which act our second claim comes under we will suppose a sale by the patentees.

If it comes under the act of July 4th, 1836, they sell the mode of constructing the bed in designs as shown by *a, b, c, d, e, f, g,* Fig. 1, and the right of using the same to grain pails and analagous bodies in staves, representing different kinds of woods, and of selling to others the right to make, use and vend said machine, constructed so as to grain as aforesaid; but if under the act of March 2d, 1861, the patentees sell simply the thing as it is designed in staves, with the right to make, vend, &c., but not the right to use this thing which we call a machine, to grain pails and analagous bodies in imitation of staves of different kinds of woods, for in so doing you make it a machine.

We think the construction the learned judge of the Supreme Court put upon this claim in his charge to the jury, correct. He says:

"Now it seems to me that a fair construction of these two claims taken together in the light of the entire context in the specifications; that the first clause claims the curved form of the bed—upon that subject I think there can be no difference of opinion. That is radical upon that point.

"Now it seems to us to be equally clear on the second claim; that which is equally prominent, and made equally distinct and emphatic is, for distinct staves, or designs, impressed upon a bed, in the form which lies before you, (referring to the machine before the jury,) or a rectangular form, for the purpose of being transferred upon wares that may be brought in contact with it. This, we think, is what is in this claim, taken in connection with the residue of the specifications, the patent was designed to secure to the inventor, and if valid, it goes to this extent and no further."

Again, if by any reason the Court should come to the conclusion that the second claim is for a design, and should have been patented under the act of 1861, we deny that, for this reason, the whole patent is void.

There is no reason or law for holding this patent void, and the inventor to be deprived of his invention under the first claim, for the simple reason that he has mistaken the law of his second claim.

Patents are not made void for any such reasons as these, and a worthy inventor deprived of what the law entitles him to, for the sole and only reason that he has included two inventions or claims under the act of 1836, when one of them should have been under the act of 1836, and the other one under the act of 1861.

The first claim, it is conceded, is properly patented under the act of 1836, and the second claim cannot invalidate it, whether the second claim comes under the act of 1836 or 1861.

SECOND POINT.

Whether said letters patent were not void for ambiguity?

On this subject we will refer the Court to the decision of Judge Story in the case of

Ames vs. Howard et al., 1 Sumner, 485.

"If the specification is wholly ambiguous and uncertain, so loosely defined, and so inaccurately expressed, that the Court cannot, upon a fair interpretation of the words, and without resorting to mere vague conjecture of intention, gather what it is, then the patent is void for this defect. But if the Court can clearly see what is the nature and extent of the claim, by a reasonable use of the means of interpretation of the language used, then the plaintiff is entitled to the benefit of it, however imperfectly and inartificially he may have expressed himself, and for this purpose, we are not to single out particular phrases, standing alone, but to take the whole in connection." Also,

Ryan vs. Goodwin, 3 Sumner, 520,

wherein the same learned Judge says:

"If, therefore, there be any ambiguity or uncertainty in any part of the specification, yet if taking the whole together, the Court can perceive the exact nature and extent of the claim made by the inventor, it is bound to adopt that interpretation, and to give it its full effect."

And as to what is required by the act of 1836 on this point, see

Hogg vs. Emerson, 6 Howard, 484.

"The degree of clearness and freedom from ambiguity required in the specifications under the act of 1793, (which is the same as the act of 1836 in this respect,) is to distinguish the invention from things before known, and to enable any person skilled in the art or science to make and use the same. But the patentee need not describe particularly, and disclaim all of the old parts, and that is especially unnecessary, when such disclaimer is manifestly in substance the result of his claiming as new, only the portions which he does describe specially."

And whether there is ambiguity in the description, is a question for the jury under the testimony of experts. See case of

Washburn vs. Gould, 3 Story, 138.

"Whether the patent is void for uncertainty and ambiguity in the description, is a matter of fact to be decided upon the evidence of experts."

The Court in construing this patent should look at it in the light of the law, as laid down by Judge Story in the case of

Ames vs. Howard, 1 Sumner, 483,

before referred to, in which he says:

"Patents for inventions are not to be treated as mere monopolies, odious in the eyes of the law, and therefore not to be favored; nor are they to be construed with the utmost rigor as *strictissimi juris*. The Constitution of the United States, in giving authority to Congress to grant such patents for a limited period, declares the object to be, to promote the progress of science and useful arts, an object as truly national and meritorious, and well founded in public policy, as any which can possibly be within the scope of national protection. Hence, it has always been the course of American Courts, (and latterly it has become that of the English Courts also,) to construe these patents fairly and liberally, and not to subject them to any over nice and critical refinements. The object is to ascertain what, from the fair sense of the words of the specification, is the nature and extent of the invention claimed by the party, and when the nature and extent of that claim are ap-

parent, not to fritter away his rights upon formal, or subtile objections, of a purely technical character."

But in the language of the same learned Judge,

Ryan et al. vs. Goodwin et al. 3 Sumner, 520,

"To give a liberal construction to the language of all patents and specifications, (*ut res magis valeat quam pere at,*) so as to protect, and not to destroy the rights of real inventors."

Looking, then, upon this patent in the light of the wisdom of the law, and of the courts, we can come to no other conclusion than that this patent is free and clear from any ambiguity.

That the first claim is on the form of the bed, (see Fig. 1,) for the purposes therein stated, and that the second claim is on the stave of the bed, whether the bed be curved or rectangular, for the purposes therein stated; the 1st claim is in substance for the bed which grains the pail; the 2d claim for the construction of the bed in staves, so that the ware, brought in contact with or rolled over it, will be grained in staves representing different kinds of woods.

JASON CANFIELD,
Att'y for Plaintiffs.

Supreme Court of the United States.

DIODATE CLARK, *et al*,)
vs
JOHN BOUSFIELD, *et al*.)

REPLY TO PLAINTIFFS' BRIEF, BY WILLEY & CARY.

The printed argument of the plaintiffs seems to mistake our position as to the second claim, and argues against it as if our position was that the second claim was for the design when imprinted on the pail or other ware. Hence, it says (page 5) "it is for a machine which grains a pail in staves," (which is begging the question,) "and not for the impression put upon the pail," which we do not contend it is. It is not the impression or design *put* upon the pail, but the impression or design on *the plate and to be* put upon or transferred to the pail that we say the second claim is for. And thus the Circuit Court say, in the first paragraph of its charge to the jury, (page 7 of Defendants' brief,) and so also in the third paragraph on the same page. And the learned counsel for the plaintiffs seems to have overlooked in his whole argument on this branch of the case, that section 11 of the act of 1861, provides not only for designs

or impressions produced, but also for "any new and useful pattern, or print, or picture, *to be* either worked on, or *printed*, or *painted*, or cast, or otherwise fixed on any article of manufacture."

Again he says, (page 5 of Plaintiffs' brief,) "And the peculiar device of putting this grain upon pails, so as to represent staves of different kinds of wood, as shown in our patent, is what is embodied in our second claim." What device? Not the plate, for that is described and secured in the *first* claim, and this claim must therefore be for the stave design, "pattern, print, or picture," *on* the plate, "to be (see section 11) worked, or printed, or painted" on; or, in other words, to be transferred to the pail. The patentees *might* have described under section 11, the stave-shaped design or picture when *produced* on a pail. That would have been for a design. They *have* described, not this, but the same design or picture *on this plate*, to be transferred to or impressed upon the pail, which is equally a design, and only patentable as such. Just as well might any plate of wood, or steel, or copper, with carved or lined surfaces, or any novel arrangement of type, be called a device or machine, and patented as such.

Again, it is suggested as an objection to this claim being held to be for a design, that the ware to which the stave-shaped picture is to be transferred is variable in size; but the answer is that however expanded or contracted, it would remain the same design.

But it is claimed that even if for a design, it does not vitiate the patent. On this we refer to page 4 of our printed brief, and to the opinion of the Circuit Court, (page 7:) "*A patent can be avoided if it claims two distinct and independent inventions, and a patent can be avoided which contains a valid claim for a machine or instrument, and which contains also a claim for a design*," &c. No authorities are cited to the contrary of this, and the saving section of the statute which relieves against an *excessive* claim, if honestly made, only applies to those cases where the inventor has been mistaken as to the extent of his

invention or the novelty of some part of it, but does not, nor is it claimed that it does, apply to a case of *want of unity* arising from combining distinct inventions, or inventions patentable under different laws. And even this saving clause requires a disclaimer within a reasonable time, and this patent has been running since December, 1864.

Finally, we say in answer, and especially to the concluding paragraph of plaintiff's brief, that if, as there claimed, the first claim "is in substance for the bed which grains the pail," then that said bed is described in a preceding part of the specification as to be constructed either in one mass or in separate panels. Hence, that this first claim covers everything except the design or "distinct designs", to be transferred or imprinted, leaving nothing to be covered, or intended to be covered by the second claim, except the stave shaped designs on the plate or bed, to be imprinted or grained upon, or transferred to, the pail or ware to be grained, so as to "present the appearance of being constructed of different kinds or species of woods," which is exactly what we claim, as held by the Circuit Court, to be the meaning and extent of this second claim, and which is the point at issue.

And we would beg a renewed examination of the suggestions contained in our first brief, not only as to this second claim, but as to the character of both the first and second claims, to determine whether either of them could be maintained, except as a claim for a design, it being obvious from the whole specification that nothing is new in these first two claims, except the design or impression on the surface of the graining plate, and the form, which is a mere obvious adaptation, by measurement, of one surface to another, and that in this view *both* of the first two claims are void.

It is not impossible, of course, that if all the four claims had been put into one claim for a combination or improved graining machine, the combination might have held; but the unwarranted subdivision of the combination into claims, which separately

show no invention as of a machine or mechanical device, carried them into the department of designs, which we submit is fatal to the patent, requiring a surrender and re-issue, before, either as a machine or a design, it can be made available to the alleged inventors.

Respectfully submitted,

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